

ARGUMENTS/REMARKS

Applicants would like to thank the examiner for the careful consideration given the present application, and for the personal interview conducted with the Examiner and her supervisor on April 24, 2007. The application has been carefully reviewed in light of the Office action and the interview, and amended as necessary to more clearly and particularly describe and claim the subject matter which applicants regard as the invention.

Claims 1-8 and 13-19 remain in this application. Claims 9-12 have been withdrawn as the result of an earlier restriction requirement, but applicant retains the right to present the withdrawn claims in a divisional application. Claims 20 and 21 have been added.

Claims 1-3, 5, 7, 14, and 18-19 were rejected under 35 U.S.C. §103(a) as being unpatentable over Niederdraenk *et al.* (U.S. 2004/0179709). Claims 4 and 13 were rejected as being unpatentable over Niederdraenk in view of Miyazaki *et al.* (U.S. 5,674,624). Claims 6 and 16 were rejected as being unpatentable over Niederdraenk in view of D'Agostino *et al.* (U.S. 6,649,222). Claims 8 and 15 were rejected as being unpatentable over Niederdraenk in view of Urso *et al.* (U.S. 6,751,327), and claim 17 rejected in further view of D'Agostino. For the following reasons, the rejections are respectfully traversed.

Claim 1 has been amended to recite a process including a step of “providing a hydrophobic coating on the housing wall at least in the area of the one or more of crevices, chinks, openings and capillaries to prevent moisture from an exterior of said housing wall from entering the one or more of crevices, chinks, openings and capillaries” where the one or more of small crevices, chinks, capillaries and openings are “in a wall of a housing which occur due to an assembly of at least two structural components”. Similarly, claim 18 recites a process with a step of “coating at least a portion of said surface in the area of said gaps with a hydrophobic coating to prevent penetration of a liquid into said gaps from an exterior of said surface”.

As discussed at the personal interview, Niederdraenk does not teach such a hydrophobic coating for preventing moisture from an exterior of a housing wall from

entering the crevices, chinks, openings and/or capillaries. It was pointed out to the Examiner that Niederdraenk discloses no details of any assembly, and that the reference fails to teach which components, if any, are assembled together to create the disclosed device. Nevertheless, the reference does not teach any means of preventing moisture from the exterior from entering the device, in particular because the coatings provided by the reference are on an interior, as are any crevices, chinks, openings and/or capillaries that the disclosed device may contain. In fact, any moisture clearly must come from an *interior* of the Niederdraenk device.

The Examiner and her supervisor agreed, at the personal interview, that the Niederdraenk reference did not teach any preventing of moisture from an exterior of the device from entering the cited features. Accordingly, claims 1 and 18 are patentable over the reference. The other cited references fail to overcome the shortcomings of the Niederdraenk reference, and thus the dependent claims, which depend, directly or indirectly upon claims 1 and 18, are all patentable over the references for at least the same reasons as the parent claims.

Further, regarding the rejection of the claims, the Examiner has not provided the proper motivation for combining the references. The burden is on the Examiner to make a *prima facie* case of obviousness (MPEP §2142). To support a *prima facie* case of obviousness, the Examiner must show that there is some suggestion or motivation to modify the reference (MPEP §2143.01). The mere fact that references can be combined or modified, alone, is not sufficient to establish *prima facie* obviousness (*Id.*). The prior art must also suggest the desirability of the combination (*Id.*). The fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient, by itself, to establish *prima facie* obviousness (*Id.*).

Merely listing an advantage or benefit of the combination is not sufficient, as some rationale for combining the references must be found in the references themselves, or drawn from a convincing line of reasoning based on established scientific principles practiced by one skilled in the art that some advantage or beneficial result would be produced by the combination (MPEP §2144). Such motivation cannot be found in the application itself, as such *hindsight* is impermissible; the facts must be gleaned from the prior art. (MPEP §2142, last paragraph).

“To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical ‘person of ordinary skill in the art’ when the invention was unknown and just before it was made [and] the examiner must then make a determination whether the claimed invention ‘as a whole’ would have been obvious at that time to that person.” (MPEP §2142, emphasis added). It is not proper to merely combine various elements from various references. The invention must be obvious “as a whole”, not as a piecemeal combination of elements from various references.

In this case, the Examiner is clearly providing hindsight motivation, which is improper. Accordingly, the rejection for obviousness is not supported by the Office action and thus the rejection is improper, and should be withdrawn.

In consideration of the foregoing analysis, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. 36348.

Respectfully submitted,
PEARNE & GORDON, LLP

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